IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of Ken Tatebe et al. Application No.: 10/551,279 Filed: September 27, 2005 For: TEST PAPER AND POROUS MEMBRANE	**MAIL STOP APPEAL BRIEF-PATENTS** Group Art Unit: 1773 Examiner: Dean P. Kwak Confirmation No.: 1584

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
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Sir:

This Reply Brief is being filed in response to arguments raised in the Examiner's Answer ("Answer") dated December 27, 2010.

In lines 8-12 on page 8 of the Answer, the Examiner evidently alleges that the Japanese publication's disclosure of an average pore size in the entirety of a layer is also a disclosure of the average pore size of the surface of the layer because the surface is part of the layer. Appellants respectfully submit that the Examiner's premise is based on flawed logic. Clearly, an average pore size within a part of a layer (here, a surface of the layer) can be different than the overall average pore size of the entire layer.

In the paragraph bridging lines 8-9 of the Answer, and also in lines 12-15 on page 10 of the Answer, the Examiner evidently alleges that the recited section density is a result-effective variable because it is related to, i.e., can vary with, an average pore size. Assuming for the sake of discussion that average pore size has been established as a result-effective variable, Appellants respectfully submit that to conclude that another variable, i.e., section density, is result-effective solely because it is related to a result-effective variable, i.e., average pore size, contradicts established case law. For example, in *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977), it was held that modifying the ratio of tank volume to contractor area in a wastewater treatment device with an eye toward maximizing treatment capacity

was not an art-recognized result effective variable, even though the prior art specifically discussed increasing the contractor area to increase efficiency, and even though varying the contractor area while keeping the tank volume constant would also vary this ratio.

In the paragraph bridging lines 9-10 of the Answer, the Examiner evidently alleges that because the prior art measures light reflected and absorbed at a surface, one of ordinary skill in the art would consider optimizing the surface glossiness so as to reduce noise in the measurement. However, Appellants respectfully submit that the Examiner has not provided any evidence that an ordinarily skilled artisan would recognize that altering the glossiness would have altered the noise in the measurement. Thus, Appellants respectfully submit that the Examiner has not established that the surface glossiness here is a result-effective variable.

In lines 11-14 on page 11 of the Answer, the Examiner states that paragraph [0009] on page 11 of the Japanese publication discloses a ratio between the average pore size in the surface of the first layer and the average pore size in the surface of the second layer in the range of 1 to 6. However, what the noted portion of the Japanese publication actually discloses is that, in the test strip, which is composed of two anisotropic membranes stacked one over the other, the first layer on a specimen-supplying side has a greater pore size on a specimen-supplying side than on a side thereof which is in contact with the second layer, and the second layer on a measuring side has a smaller pore size on a side thereof which is in contact with the first layer than on a measuring side. If the above two layers were made as one layer, the layer has a smaller pore size towards the inside thereof from a surface on a specimen-supplying side and has a greater pore size towards a surface thereof on an opposite, measuring side. However, the respective average pore sizes of the two interior surfaces is not mentioned. Accordingly, it cannot be concluded that the ratio of the average pore sizes of the first and second outer surfaces is in the range of 1 to 6.

Moreover, the noted portion of the Japanese publication discloses that the ratio of the average pore size of the surface on the specimen-supplying side to the average pore size of the surface which is in contact with the second layer is

disclosed as 2.0 or greater, while the ratio of the average pore size of the surface on the side, where the particular component in the specimen is measured, to an average pore size of the surface, which is in contact with the first layer, is 1.5 or greater. Thus, even assuming that the respective average pore sizes of the two interior surfaces are the same, the disclosed ratios suggest, if anything, that the first outer surface in the Japanese publication test paper should have a larger pore size than the second outer surface. By contrast, the claimed ratio requires the first surface to have the same or smaller pore size than the second surface.

The remaining points in the Examiner's Answer are addressed in the Appellants' Appeal Brief, and therefore are not discussed further herein. For the reasons presented in the previously filed Appeal Brief and this Reply Brief, Appellant respectfully submits that the rejections of the claims are not supported by the cited prior art references.

Respectfully submitted,

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